

## REMARKS

Claims 1-16, 18-24, 26-48, 50-56, and 58-69 are pending in the application. The specification is objected to. Claims 1-16, 18-24, 26-31, 64, 66, and 69 are withdrawn. Claims 32-48, 50-56, 58-63, 65, and 67-68 stand objected to. Claim 67 stands rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claim 68 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 32-48, 50-56, 58-63, 65, and 67-68 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting over claims 1-16 of co-pending U.S. Patent Application Serial No. 11/321,114 and claims 1-20 of U.S. Patent No. 6,012,039. Claim 67 is indicated as allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, ¶ 2. Claim 68 is indicated as allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 101. Claims 32-48, 50-56, 58-63, 65, and 67-68 are indicated as allowable if rewritten or amended to overcome the claim objections and the double patenting rejection.

Reconsideration is requested. The rejections are traversed. No new matter is added. Claim 68 is amended. Claims 1-16, 18-24, 26-31, 64, 66, and 69 are canceled. Claims 32-48, 50-56, 58-63, 65, and 67-68 remain in the case for consideration.

The Applicant objects to the finality of this Office Action. The Examiner has introduced a double patenting rejection for the first time in this application. While the Examiner had issued a similar double patenting rejection in the Office Action dated November 21, 2008, the Examiner acknowledged in a communication dated March 4, 2009 that the double patenting rejection in that Office Action was not proper, as no claims were identified in U.S. Patent Application Serial No. 11/321,114 or U.S. Patent No. 6,012,039. Further, the amendments made to the claims in this application since the decision by the Board of Patent Appeals and Interferences have not broadened the broadest claims. Therefore, if the claims as they currently stand are properly rejected as double patented, then the claims as they stood after the decision by the Board of Patent Appeals and Interferences were also double patented. But if the claims as they stood prior to the Office Action dated June 18, 2008 could have been rejected as double patented, then the amendments made to the claims since June 13, 2008 did not necessitate the double patenting rejection, and therefore finality is improper.

The Examiner has also introduced a rejection under 35 U.S.C. § 112, ¶ 2 for the first time in this application. The Examiner rejects claim 67 as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the

invention. This rejection has not been made in any previous Office Action since the decision by the Board of Patent Appeals and Interferences, nor has claim 67 been amended since that time. (The Applicant acknowledges that some claims have been amended since the Office Action dated June 13, 2008: for example, claim 32 was amended in response to the Office Action dated June 13, 2008. However whether the “means for receiving” feature of claim 67 is definite is independent of the amendment to claim 32: if claim 67 is indefinite now, it was indefinite before claim 32 was amended. Therefore, the fact that there might have been amendments to other claims in this application since June 13, 2008 does not affect the timing of the application of 35 U.S.C. § 112, ¶ 2.) Accordingly, this is a new ground of rejection not necessitated by the Applicant’s amendment, and finality is improper.

#### INTERVIEW SUMMARY

On December 14, 2009, the undersigned spoke with Examiners Zelaskiewicz and Fischer. Agreement was reached regarding an amendment to claim 68 to overcome the rejection under 35 U.S.C. § 101, and identification in the specification as to the structure to support “means for receiving” as recited in claim 67. The Examiners also clarified that there were two double patenting rejections: one provisional over U.S. Patent Application Serial No. 11/321,114, and one over U.S. Patent No. 6,012,039.

#### SPECIFICATION OBJECTION/REJECTIONS UNDER 35 U.S.C. § 112, ¶ 2

The Examiner objects to the specification, arguing that there is no support for the claim feature “means for receiving”, recited in claim 67. The Examiner rejects claim 67 under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. The Examiner interprets this feature under 35 U.S.C. § 112, ¶ 6, and argues that “the written description fails to disclose the corresponding structure, material, or acts for the claimed function” (*see* Office Action dated October 14, 2009, page 4). The Applicant respectfully disagrees.

First, the Applicant believes the specification discloses sufficient structure for the “means for receiving” feature. For example, the specification recites “[f]or systems employing a personal identification code (PIC), the PIC is gathered using a keypad or PIC pad that is preferably located securely inside the BIA” (*see* specification, page 32, lines 14-15). The Applicant believes that such a keypad is an example of a structure that can receive the personal identification code (although the specification may recite other such structures as

well). Accordingly, the Applicant respectfully requests the Examiner to withdraw the specification objection and the rejection of claim 67 under 35 U.S.C. § 112, ¶ 2.

Finally, the Applicant objects to the Examiner's assertion that "because the claims are indefinite under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, it is impossible to properly construe the claim scope at this time" (*see* Office Action dated October 14, 2009, page 5). Claim 67 has been present in this application since before the Office Action dated June 13, 2008, and has not been amended in all this time. If claim 67 is now sufficiently indefinite that the claim scope cannot be properly construed at this time, then the claim scope could not have been properly construed since the Office Action dated June 13, 2008. Since the Examiner was apparently able to properly construe the claim scope before, the Applicant believes it should be possible to properly construe the claim scope now.

### CLAIM OBJECTIONS

On the Office Action Summary page in the Office Action dated October 14, 2009, the Examiner indicates that claims 32-48, 50-56, 58-63, 65, and 67-68 are objected to. But the Applicant fails to see any objections to any claims in the Office Action. An objection relates to the form of the claim (*see, e.g.*, M.P.E.P. § 706.01), but the Examiner has not indicated that there are any problems with the form of any claims. (The Office Action does include a section labeled "Allowable Subject Matter" (*see* Office Action dated October 14, 2009, pages 8-9), but every claim is rejected on some ground, be it 35 U.S.C. § 112, ¶ 2, 35 U.S.C. § 101, or a double patenting rejection. The Applicant interprets the Examiner's objection to the claims to be an acknowledgment that, except for the rejections under 35 U.S.C. §§ 101 and 112, ¶ 2 and the double patenting rejection, the claims are allowable over all the prior art of record.

### REJECTIONS UNDER 35 U.S.C. § 101

The Examiner rejects claim 68 as failing to meet the *Bilski* test. Specifically, the Examiner asserts that the claims are not tied to a particular machine or apparatus, and do not transform a particular article to a different state or thing. The Examiner goes on to state that "the process claims fail prong (1) because the method steps of electronic communication formation, bid biometric transmittal, user identifier, electronic communication authorization, rule-module invocation, and electronic communication execution are not tied to a specific machine since the method step[s] could be performed by a human being" (*see* Office Action dated October 14, 2009, page 6). The Applicant respectfully disagrees.

First, the Applicant has amended claim 68 as agreed in the telephone interview of December 14, 2009, which should be sufficient to overcome the rejection under 35 U.S.C. § 101.

Second, the Applicant respectfully points out that a human being cannot form an electronic communication “comprising electronic data”. Human beings can only manipulate physical objects: we cannot “touch” or otherwise manipulate “electronic data”. Similarly, human beings cannot “electronically transmit” a bit biometric sample without using a machine. Human beings can use machines to manipulate electronic data; but then, per force, there is a machine in the system, and so the claim would have to meet the first prong of the *Bilski* test.

Third, the Applicant respectfully points out that claim 68 recites an “electronic identifier”. This is a particular machine (*see, e.g.*, specification, page 40, line 3 through page 42, line 1). Accordingly, the Applicant believes claim 68 meets the first prong of the *Bilski* test.

Fourth, the Applicant also believes claim 68 satisfies the second prong of the *Bilski* test, in that the claim transforms data that represents aspects of the real world. In *In re Abele*, 684 F.2d 902 (C.C.P.A. 1982) the predecessor of the Federal Circuit held that claims that manipulate data representing physical and tangible objects are statutory subject matter under 35 U.S.C. § 101. This test was expressly approved by the Federal Circuit in *Bilski* (*see In re Bilski*, slip opinion 07-1130, pages 24-26 (“We further note for clarity that the electronic transformation of the data itself into a visual depiction in *Abele* was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented.”)). The claimed invention similarly manipulates data that is representative of something external to the computer: in this case, user’s biometric. Specifically, the claims transform the user’s biometric into an identification of the user, which enables the method to authorize the electronic communication. This shows that the claim also performs a transformation, which is patentable under the second prong of the *Bilski* test.

#### DOUBLE PATENTING REJECTIONS

The Examiner states that “[c]laims 32-48, 50-56, 58-63, 65, and 67-68 in the instant application are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-16 in co-pending application 11/321,114 and claims 1-20 in US patent 6,012,039” (*see* Office Action dated October 14, 2009, page 7). Based on the telephone interview of December 14, 2009, the Applicant understands there to

be two separate double patenting rejections: one provisional over U.S. Patent Application Serial No. 11/321,114, and one over U.S. Patent No. 6,012,039.

The Applicant submits herewith a terminal disclaimer to overcome the double patenting rejections.

#### RESPONSE TO THE EXAMINER'S CLAIM INTERPRETATION

The Examiner notes that, responsive to the Restriction Requirement dated June 9, 2009, the Applicant elected to pursue the apparatus claims. The Examiner states that "Applicants are reminded that functional recitations using the word and/or phrases "for", "adapted to", or other functional language (*e.g.* see claim 32 which recites "data entry device *for* formation", "device *for* electronically scanning") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language" (*see* Office Action dated October 14, 2009, page 10; emphasis in original). The Examiner goes on to state that "all limitations have been considered" (*see* Office Action dated October 14, 2009, page 10), but then cites M.P.E.P. § 2106.II.C for the proposition that "[l]anguage that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (*see* Office Action dated October 14, 2009, page 11; emphasis in original). The Examiner then suggests that "claims 32 and 68 state 'wherein an electronic communication is biometrically-authorized *without* the user having to present smartcards or magnetic stripe cards.' To assisting in overcoming prior art rejections, Examiner suggests that Applicant re-write claims 32-48, 50-56, 58-63, 65, and 67-68 in the affirmative, without the 'negative' limitation" (*see* Office Action dated October 14, 2009, page 11; emphasis in original).

"The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph" (*see* M.P.E.P. § 2173.05(i)). The Applicant also points out that the "without the user having to present smartcards or magnetic stripe cards" focused on by the Examiner is not an optional limitation: if a smartcard or magnetic strip card is used in the transaction, then the claims would not be infringed. Therefore, this claim feature does limit the scope of the claims, and further does not need to be amended simply because it is a "negative limitation".

For the foregoing reasons, reconsideration and allowance of claims 32-48, 50-56, 58-63, 65, and 67-68 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



Ariel S. Rogson  
Reg. No. 43,054

MARGER JOHNSON & McCOLLOM, P.C.  
210 SW Morrison Street, Suite 400  
Portland, OR 97204  
503-222-3613  
Customer No. 60460